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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

Applicant: Schulz
Title: PAPER TRIMMER
Appl. No.: 10/057,850
Filing Date: January 25, 2002
Examiner: Charles Goodman
Art Unit: 3724

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BRIEF ON APPEAL

Commissioner for Patents
PO Box 1450
Alexandria, Virginia 22313-1450

Sir:

Under the provisions of 37 C.F.R. § 1.192, this Appeal Brief is being filed in triplicate together with a check in the amount of \$330.00 covering the Rule 17(c) appeal fee. If this fee is deemed to be insufficient, authorization is hereby given to charge any deficiency (or credit any balance) to the undersigned deposit account 06-1450.

REAL PARTY IN INTEREST

Alterra Holdings Corporation is the real party of interest as a result of an assignment from the inventor, William J. Schulz. This assignment was recorded in the United States Patent and Trademark Office on April 22, 2002 at Reel 012819, Frame 0717.

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RELATED APPEALS AND INTERFERENCES

There are no related appeals and/or interferences.

STATUS OF CLAIMS

Claims 1-17 and 19-24 are pending¹. Claims 1-15, 17, 19-21 and 23-24 stand rejected under 35 U.S.C. § 102(b) as anticipated by U.S. Patent No. 5,802,942, issued to Cornell et al.

Claims 16 and 22 stand rejected under 35 U.S.C. § 103 as obvious in view of U.S. Patent No. 5,802,942, issued to Cornell et al. in view U.S. Patent No. 4,967,628, issued to Judd et al.

The claims in their current condition are attached hereto in the Appendix.

STATUS OF AMENDMENTS

No amendments are outstanding.

SUMMARY OF INVENTION

The present invention relates to a paper trimmer comprising a base including a support surface and a cutting region having a channel, and a plate pivotally attached to the base. The plate includes an upper surface, a lower surface, a first end, a second end, and a slot extending through the plate along a longitudinal axis of the plate intermediate the first and second ends. The slot includes a first width at a first portion thereof and a second width at a second portion thereof, with the first width being larger than the second width. A carrier is slidably received in the slot and sized to be removed from the slot when positioned adjacent the

¹ Appellant inadvertently omitted any claim 10 from the original application. There is therefore no claim 10 currently pending.

first width of the slot and impeded from being removed when positioned adjacent the second width of the slot. A blade is attached to the carrier, with a portion of the blade extending below the lower surface of the plate within the channel when the plate is disposed over the cutting region.

The present invention also relates to a material trimmer comprising a base having a support surface and a cutting region having a channel, and a plate movably attached to the base. The plate includes oppositely facing upper and lower surfaces, an elongated slot therethrough, an elevated portion proximate each side of the slot, with the elevated portion leading to an arcuate surface, and a distal second end. A carrier includes a top flange having a pair of oppositely extending sides, a foot extending from the top flange, with the foot being slidably received within the slot, and a portion of the pair of oppositely extending sides being arcuate in shape and slidably received within the arcuate surface of the elevated portion. A blade is attached to the carrier, with a portion of the blade extending below the lower surface of the plate within the channel when the plate is disposed over the cutting region. The slot has differing minimum and maximum widths, wherein the foot is capable of being removed from the slot when the carrier is positioned adjacent the maximum width of the slot, and wherein the foot is substantially incapable of being removed from the slot when the carrier is positioned adjacent the minimum width of the slot.

The present invention also provides for a material cutter comprising a base having a support surface and a cutting region having a channel, and a plate movably attached to the base. The plate includes oppositely facing upper and lower surfaces, an elongated slot therethrough, an

angled portion proximate each side of the slot, with the angled portion leading to an arcuate surface, and a distal second end. A carrier includes a top flange having a pair of oppositely extending sides, a foot extending from the top flange, with the foot being slidably received within the slot, and a portion of the pair of oppositely extending sides being substantially cylindrical in shape and slidably received within the arcuate surface of the elevated portion. A blade is attached to the carrier, with a portion of the blade extending below the lower surface of the plate within the channel when the plate is disposed over the cutting region. The slot has a nonuniform width such that the carrier can be removed from the slot when the carrier is adjacent a maximum width of the slot.

ISSUES

The first issue is whether the inventions as claimed in claims 1-15², 17, 19-21 and 23-24 are anticipated by U.S. Patent No. 5,802,942, issued to Cornell et al. under 35 U.S.C. § 102(b).

The second issue is whether the inventions as claimed in claims 16 and 22 would have been obvious to a person of ordinary skill in the art, at the time the invention was made, under 35 U.S.C. § 103 in view of U.S. Patent No. 5,802,942, issued to Cornell et al. in view U.S. Patent No. 4,967,628, issued to Judd et al.

The claims in their current condition are attached hereto in the Appendix.

² Appellant inadvertently omitted any claim 10 from the original application. There is therefore no claim 10 currently pending.

GROUPING OF CLAIMS

Claims 1-9, 11-15, 17, 19-21 and 23-24 are all rejected as being anticipated by the same reference and therefore will be discussed together as a first group.

Claims 16 and 22 are all rejected as being rendered obvious by the same pair of references and therefore will be discussed together as a second group.

ARGUMENT

A. Background

Claims 1-9, 11-17 and 19-24 are pending.

The present application was filed on January 25, 2002 with 25 claims. A first Official Action was mailed on April 1, 2003. In addition to a formal objection, the Examiner rejected all of the claims under 35 U.S.C. § 112 due to a lack of antecedent basis in some claims and other informalities. The Examiner rejected 1-15, 17-21 and 23-25 under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 5,802,942, issued to Cornell et al. The Examiner also rejected claims 16 and 22 under 35 U.S.C. § 103 as being obvious based upon U.S. Patent No. 5,802,942, issued to Cornell et al. in view U.S. Patent No. 4,967,628, issued to Judd et al.

Applicant filed an Amendment and Reply to the April 1, 2003 Official Action on June 11, 2003. In this Amendment and Reply, Applicant amended claims 1, 4, 5, 13 and 17 to overcome the Examiner's rejections under 35 U.S.C. § 112. In response to the Examiner's rejections under 35 U.S.C. §§ 102(b) and 103, Applicant traversed the rejections, arguing with particularity that the prior art cited by the Examiner failed to disclose the feature in claim 1 of a slot having a first width at a first portion thereof and a second width at a second portion thereof, the first width being larger than the second width, wherein the carrier is sized to be removed

from the slot when positioned adjacent the first width of the slot and impeded from being removed adjacent the second width of the slot. Also see similar features in claims 17 and 24.

In the Final Office Action mailed August 27, 2003, the Examiner repeated the rejections of claims based on U.S. Patent No. 5,802,942, issued to Cornell et al. in view U.S. Patent No. 4,967,628, issued to Judd et al. In response, Appellant filed a Notice of Appeal on November 25, 2003.

B. Discussion – Claims 1-5, 17, 19-21 and 23-24 are not Anticipated by U.S. Patent No. 5,802,942

The Examiner has not made an adequate showing that claims 1-5, 17, 19-21 and 23-24 are anticipated by U.S. Patent No. 5,802,942, issued to Cornell et al. More particularly, the Examiner has failed to cite any reference that discloses a paper trimmer or a material trimmer comprising a plate that includes a slot having a nonuniform width to permit the placement and removal of a carrier.

For a prior art reference to anticipate the claim of a patent, the reference must disclose each and every limitation of a claimed invention. See *Apple Computer, Inc. v. Articulate Systems, Inc.*, 234 F.3d 14, 20 (Fed. Cir. 2000). To make a prima facie case of anticipation, the Examiner must show that a reference contains a disclosure which is specific as to every element of the claims at issue. See, e.g., *In re Jochen Wagner and Helmut Wiss*, 2001 WL 1048474 (B. Pat. App & Interf. 2001), *In re Wilder*, 57 C.C.P.A. 1314, 1319, 429 F.2d 447, 451 (C.C.P.A. 1970). In this case, U.S. Patent No. 5,802,942 to Cornell et al. does not disclose every limitation of claims 1-5, 17, 19-21 and 23-24.

Independent claim 1 of the present application claims a paper trimmer comprising four principal elements:

- a base including a support surface and a cutting region having a channel;
- a plate pivotally attached to the base and including an upper surface, a lower surface, a first end, a second end, and a slot extending through the plate along a longitudinal axis of the plate intermediate the first and second ends, the slot having a first width at a first portion thereof and a second width at a second portion thereof, the first width being larger than the second width;
- a carrier being slidably received in the slot and sized to be removed from the slot when positioned adjacent the first width of the slot and impeded from being removed when positioned adjacent the second width of the slot; and
- a blade attached to the carrier, wherein a portion of the blade extends below the lower surface of the plate within the channel when the plate is disposed over the cutting region.

Similarly, claim 17 claims a material trimmer having a plate movably attached to a base and including an elongated slot, wherein the slot has differing minimum and maximum widths, and wherein a foot of a carrier is capable of being removed from the slot when the carrier is positioned adjacent the maximum width of the slot, and wherein the foot is substantially incapable of being removed from the slot when the carrier is positioned adjacent the minimum width of the slot. Likewise, claim 24 claims a material cutter having a plate movably attached to a base and including an elongated slot, wherein the slot has a nonuniform width such that the carrier can be removed from the slot when the carrier is adjacent a maximum width of the slot.

Claims 1-15, 17, 19-21 and 23-34 stand rejected under 35 U.S.C. § 102(b) as anticipated by U.S. Patent No. 5,802,942 to Cornell et al. ("Cornell"). The Cornell et al. patent

describes a paper trimmer comprising a base and a plate pivotally attached to the base. The plate has a slot extending through the plate, and a carrier including a blade. Importantly, the carrier is snap fit within the slot of the plate. (col. 5, ll. 11-12). In particular, the plate is formed of a resilient material, which permits a bottom flange of the carrier to be placed within the slot. (col. 5, ll. 12-14). The snap means may also include the carrier having a flexible bottom flange, with the plate being rigid. (Col. 5, ll. 50-51).

The Cornell et al. patent is completely silent as to the feature of a slot having a nonuniform width to permit the placement and removal of the carrier. “A prior art reference anticipates a claim only if the reference discloses, either expressly or inherently, every limitation of the claim.” *Rowe v. Dror*, 112 F.3d 473, 42 U.S.P.Q.2d 1550, 1553 (Fed. Cir. 1997) (emphasis added).

Claims 1-9 and 11-16 all include the feature of the slot having a first width at a first portion thereof and a second width at a second portion thereof, the first width being larger than the second width, wherein the carrier is sized to be removed from the slot when positioned adjacent the first width of the slot and impeded from being removed adjacent the second width of the slot. Similarly, claims 17 and 19-23 describe a slot with differing minimum and maximum widths, wherein the foot of the carrier is capable of being removed from the slot when the carrier is positioned adjacent the maximum width of the slot, and wherein the foot is substantially incapable of being removed from the slot when the carrier is positioned adjacent the minimum width of the slot. Claim 24 describes a slot having a nonuniform width such that the carrier can

be removed from the slot when the carrier is adjacent a maximum width of the slot. The Cornell et al. reference does not teach, disclose or even suggest this feature.

The above features are also not taught, disclosed or even suggested by any of the prior art cited by the Examiner, either alone or in combination. The Cornell et al. reference utterly fails to disclose or even suggest the use of a slot with a nonuniform width such that the user can selectively remove the carrier from the slot depending upon the carrier's relative position. This structure provides a number of substantial benefits to the user, not the least of which includes providing the user with the ability to easily remove and/or replace the carrier for purposes such as replacing the cutting blade. This arrangement also substantially eliminates any stresses on the carrier and/or the plate during the insertion and/or removal of the carrier, as no snap-fitting is necessary to correctly position or remove the carrier. The Cornell et al. reference cited by the Examiner is completely silent as to this issue. In fact, the Cornell reference does not even mention the words "uniform," "nonuniform," or "vary" anywhere inside the patent.

In the Final Official Action dated August 27, 2003, the Examiner asserted that "[t]he argued features are exactly the same as shown in Fig. 11, which is the same as that shown in Figs. 3-4 in Cornell et al." However, even a cursory examination of Figs. 3-4 reveals that those particular Figures of the Cornell et al. reference are completely inapplicable to issues in the present application. The feature at issue in the currently pending claims relates to the nonuniform width of the slot. A slot is designated as item 60 in the Cornell et al. reference. However, neither the slot nor item 60 is shown or identified anywhere in Figures 3 or 4. Furthermore, even if the slot were explicitly or implicitly identified in Figures 3 or 4, it is readily

apparent that one still would not be able to glean any information from these Figures about the uniformity (or lack of uniformity) of the slot. Both of Figures 3 and 4 are cross-sectional views of the paper trimmer and provide absolutely no information as to the width of the slot, much less whether the width changes along the slot's length. Furthermore, Figures 1 and 2 of the Cornell et al. reference, which have not been discussed or even mentioned by the Examiner, show the slot 60 as being completely uniform in width, showing no variance whatsoever that would permit a user to either insert or remove the carrier from the slot 60.

Because the Cornell et al. reference does not expressly or inherently describe the feature of a slot having varying widths, Appellant submits claims 1-9, 11-15, 17, 19-21 and 23-34 are not anticipated by the Cornell et al. reference.

C. Discussion – Claims 16 and 22 are not Rendered Obvious by U.S. Patent Nos. 5,802,942 and 4,967,628

The Examiner has not made an adequate showing that claims 16 and 22 are not rendered obvious by U.S. Patent No. 5,802,942, issued to Cornell et al., in view of U.S. Patent No. 4,967,628, issued to Judd et al. More particularly, the Examiner has again failed to cite any reference that discloses a paper trimmer or a material trimmer comprising a plate that includes a slot having a nonuniform width to permit the placement and removal of a carrier.

In *In re Rijckaert*, 9 F.3d 1531, 1532, (Fed. Cir. 1993), the Federal Circuit outlined the burden on the PTO as follows:

In rejecting claims under 35 U.S.C. 103, the examiner bears the initial burden of presenting a *prima facie* case of obviousness. *In re Oetiker*, 977 F.2d 1443, 1445, 24 U.S.P.Q.2d 1443, 1444 (Fed. Cir. 1992). Only if that burden is met, does the burden of coming forward with evidence or argument shift to the applicant. *Id.* “A

prima facie case of obviousness is established when the teachings from the prior art itself would appear to have suggested the claimed subject matter to a person of ordinary skill in the art.” *In re Bell*, 991 F.2d 781, 782, 26 U.S.P.Q.2d 1529, 1531 (Fed. Cir. 1993) (quoting *In re Rinehart*, 531 F.2d 1048, 1051, 189 U.S.P.Q. 143, 147 (CCPA 1976)). If the examiner fails to establish a *prima facie* case, the rejection is improper and will be overturned. *In re Fine*, 837 F.2d 1071, 1074, 5 U.S.P.Q.2d 1596, 1598 (Fed. Cir. 1988).

To establish a *prima facie* case of obviousness, three basic criteria must be met.

First, there must be some reasonable suggestion or motivation to modify the prior art reference or to combine reference teachings. Second, there must be a reasonable expectation of success of achieving the desired goals. Finally, the prior art references when combined must teach all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on the Applicant’s disclosure. *In re Vaeck*, 947 F.2d 488 (Fed. Cir. 1991).

Claims 16 and 22 of the present application, both of which are dependent claims, are directed to the feature of having a measuring instrument rotatably coupled to the base of the paper trimmer or the material trimmer. The Examiner has noted that the Judd et al. reference discloses a measuring instrument rotatably coupled to the base of a trimmer device. However, the Examiner again failed to address the fact that the Cornell et al reference utterly fails to disclose, teach or even suggest a plate including a nonuniform slot for enabling a user to easily insert or remove the carrier. This feature is also entirely absent from the Judd et al. reference, which clearly shows a uniform guidance slot 16 in Figure 1 of the patent. Because this limitation

cannot be found in either of the prior art references cited by the Examiner, the only reasonable conclusion is that the rejection of claims 16 and 22 under 35 U.S.C. § 103 is improper.

CONCLUSION

Claims 1-9, 11-15, 17, 19-21 and 23-24 are not anticipated by U.S. Patent No. 5,802,942, issued to Cornell et al. Additionally, claims 16 and 22 would not have been obvious to a person of ordinary skill in the art, at the time the invention was made in view of U.S. Patent No. 5,802,942, issued to Cornell et al, and U.S. Patent No. 4,967,628, issued to Judd et al. Accordingly, favorable consideration and allowance of the application is respectfully requested.

Respectfully submitted,

Date

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